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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/716,358	11/17/2003	Xiandong Wang	08935-295001	7033
26161	7590	12/31/2007		
FISH & RICHARDSON PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022				
			EXAMINER	
			WILLS, MONIQUE M	
			ART UNIT	PAPER NUMBER
			1795	
			MAIL DATE	DELIVERY MODE
			12/31/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/716,358

Applicant(s)

WANG ET AL.

Examiner

Monique M. Wills

Art Unit

1795

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35, 42-51 and 53-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9, 21 and 35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Request for Continued Examination

The request filed on October 17, 2007 for a Request for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 10/716358 is acceptable and a RCE has been established. An action on the RCE follows.

The following rejections are overcome:

- The Terminal Disclaimer filed August 28, 2006 was received.
Therefore, the rejection of claims 1-15, 17—18, 20-30, 32-35 & 42-52 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9, 30—39, 60—72 & 92-97 of U.S. Patent No. 10/913,922, is overcome.
- Claims **22-23 & 27-30, 32-35 & 49-52** rejected under 35 U.S.C. 103(a) as being obvious over Passaniti et al. U.S. Patent 6,001,508.

Allowable Subject Matter

Claims 1-9 & 42-44 are allowable over the prior art of record, because the prior art is silent to a primary battery comprising a cathode with an oxide containing the metals of the composition of claim 1.

Claims 4-5 are allowable over the prior art of record now that the provisional double patenting rejection is overcome, because the prior art is silent to a cathode oxide, wherein an electrically conductive portion of carbon or metal oxide is coated on the cathode material.

Claims 10-16 & 19 are allowable over the prior art of record, because the prior art is silent to a primary battery comprising a cathode oxide, wherein the oxide comprises an alkaline earth metal and pentavalent bismuth. Claims 17-18 & 20-21 & 45-48 are allowed based on their dependency on claim 10.

Claims 24-26 & 31 are allowable over the prior art of record, because the prior art is silent to a primary battery comprising a cathode with an oxide containing the metals of claims 24-25 & 31 and pentavalent bismuth.

Claims 22-23 & 27-30, 32-35 & 49-51 & 53-63 are allowed based on Applicant's argument set forth in the remarks filed October 17, 2007.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9, 21 & 35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to the term "capable of" it has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Huchison, 69 USPQ 138. Therefore, the limitations are of uncertain meaning rendering the claims vague and indefinite. An appropriate correction is required.

Response to Arguments

Applicant's arguments, see pages 1-5, filed October 17 2007, with respect to Passaniti having no relevance to cathodes including other types of primary active material. have been fully considered and are persuasive. The rejections have been withdrawn.

Conclusion

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Monique Wills whose telephone number is (571) 272-1309. The Examiner can normally be reached on Monday-Friday from 8:30am to 5:00 pm.

If attempts to reach Examiner by telephone are unsuccessful, the Examiner's supervisor, Patrick Ryan, may be reached at 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the

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Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MW

12/22/07

MARK RUTHKOSKY
PRIMARY EXAMINER

For PATRICK RYAN

Mr. Ruthkosky 12-26-07